

### **REMARKS**

In the Office Action, the Examiner rejected pending claims 1-55. By this paper, Applicants added new claims 56-59. No new matter has been added. In view of the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

#### **Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-55 under 35 U.S.C. § 103(a) as being unpatentable over Erwin et al (US Patent 6,249,770 B1, hereinafter "Erwin") further in view of Huang et al. (US Patent No. 6,151,582A, hereinafter "Huang"). Applicants respectfully traverse this rejection. Specifically, the Examiner stated:

Erwin discloses (see columns 1-20) all the steps, methods, and means described in claims 1-55, including a method for providing a financial outlook for a medical facility, providing an electronic form having fields for entering financial data of the medical facility associated with at least one of the plural [sic] of modalities, the financial data comprising projected changes in at least a portion of the financial data over a future analysis period, electronically receiving the financial data from the electronic form via a network, routing the financial data into a financial analysis system, generating pro forma report the future analysis period tailored to the financial data, electronically transmitting the pro forma financial report to a client via the network, a system for generating financial statistics for a medical facility, a method for analyzing finances of a healthcare facility, an internet financial analysis system for financially evaluating a healthcare facility, and analyzing a desired purchasing option selected from a plurality of different options to obtain a medical imaging system based on the financial data client to provide a client-specific financial analysis of the desired purchasing option.

Erwin does not specifically teach a medical facility and he does not specifically teach purchasing analysis.

Hu discloses purchasing analysis (see columns 1-144, but in particular columns 1-12).

Office Action, pages 2-3.

***Legal Precedent***

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to modify* the teachings of the reference. See *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Second, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. §

2143.01. Similarly, if a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Lastly, it is improper to combine references when the combination requires substantial reconstruction or redesign of the main reference to arrive at the claimed invention. *In re Ratti*, 123 U.S.P.Q. at 349.

Third, non-analogous art cannot properly be pertinent prior art under 35 U.S.C. § 103. *In re Pagliaro*, 210 U.S.P.Q. 888, 892 (C.C.P.A. 1981). For the teachings of a reference to be prior art under 35 U.S.C. § 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the particular problem with which the invention pertains. *In re Horne*, 203 U.S.P.Q. 969, 971 (C.C.P.A. 1979). The determination of whether a reference is from a non-analogous art is set forth in a two-step test given in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 220 U.S.P.Q. 584 (Fed. Cir. 1984). In *Union Carbide*, the court found that the first determination was whether “the reference is within the field of the inventor’s endeavor.” If it is not, one must proceed to the second step “to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.” See *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1993). In regard to the second step, *Bott v. Fourstar Corp.*, 218 U.S.P.Q. 358 (E.D. Mich. 1983) determined that “analogous art is that field of art which a person of ordinary skill in the art would have been apt to refer in attempting to solve the problem solved by a proposed invention.” “To be relevant the area of art should be where one of ordinary skill in the art would be aware that similar problems exist.” *Id.*

### ***Deficiency of the Rejection***

Applicants also emphasize that the Examiner’s rejections are vague regarding the various claim features. See 37 C.F.R. § 1.104(c)2; M.P.E.P. § 707.07 (directing that “[w]hen a reference is complex or shows or describes inventions other than that claimed

by the applicant, the particular part relied on must be designated as nearly as practicable” and that “[t]he pertinence of each reference, if not apparent, must be clearly explained in each rejected claim specified.”). Here, the Examiner did not designate the particular part of the cited references in rejecting the instant claims. Instead, the Examiner paraphrased the claims without pointing to any coherent passage in the cited references. Furthermore, the Examiner did not point to a particular item or feature in either reference that correlated with features of the present claims. The Examiner must meet the threshold burden of presenting a combination of references, or a modified reference, which teaches *all* of the features of a recited claim. Applicants respectfully assert that pure conjecture will not do. *See* M.P.E.P. § 706

***The Examiners Assertion of Intended Use is Incorrect***

Applicants emphasize that the nature of the *interfaces, forms, reports, client data, and financial analysis systems* are *unique* to financial/client data of *medical facilities, healthcare facilities, modalities, healthcare procedures, healthcare categories*, and so forth, as recited in the present claims. Therefore, the claims do not recite a well-known process or an intended use as suggested by the Examiner. Rather, the recitations of present claims relate to specific configurations not disclosed by the Erwin and Huang references. Applicants believe each of the present claims is structurally distinct from the Erwin and Huang features, and would be recognized as such by one of ordinary skill in the art. For example, the Erwin business forms, reports, and other techniques are strikingly different than the recited features of the present claims. *See, e.g.,* Erwin, col. 5, lines 20-37 and Figures 2-27. By way of example, it is not possible to utilize the Erwin forms, reports, and systems for financial analyses of sophisticated exemplary modalities, such as medical diagnostic and imaging systems (e.g., computed tomography (CT) systems, x-ray systems, magnetic resonance (MR) systems, positron emission tomography (PET) systems, ultrasound systems, nuclear medicine systems, and so forth). *See e.g.,* Erwin col. 1, lines 12-15, 25-30; col. 3, lines 30-34; and Specification, pages 2 and 5.

***Features of Independent Claim 1 Missing From the Cited Combination***

Claim 1 recites “providing an electronic form having fields for entering *financial data of the medical facility associated with* at least one of a plurality of *modalities*.” In contrast, the Erwin reference discloses non-medical input *forms* for typical financial data of a business or company. *See* col. 5, lines 20-37. As appreciated by those skilled in the art, the types of the forms described in Erwin are clearly inappropriate for entering financial medical modality data. *See, e.g.,* Erwin, col. 5, lines 20-37 and Figures 2-27. Both the Erwin and Huang references are completely devoid of *forms* or *fields* for entering financial data of a *medical facility associated with a modality*. *See, e.g.,* Erwin, col. 5, lines 20-37. Also, claim 1 recites more than an intended use because the claim features clearly include *electronic forms and fields specifically for medical facilities and modalities* in the body (not the preamble) of the claim. *See* Office Action Mailed October 8, 2004, page 2 (asserting erroneously that a medical facility is simply an intended subject use of [the present] invention and the function or intended use described in [present] claims 1-50 can applied to any facility or business operations, services, or products.”); *see also In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974) (explaining that all claim elements must be considered in evaluating patentability of the claim). Because the Erwin and Huang references, taken alone or in combination, do not suggest or teach an *electronic form* having *fields* appropriate for *medical facility data associated with a modality*, independent claim 1 and its dependent claims are believed to be allowable over the cited combination.

Further, claim 1 recites “financial data of the medical facility associated with . . . modalities, the financial data comprising projected *changes . . .* over a future *analysis* period . . . [and] generating a pro forma financial report for the future analysis period tailored to the financial data.” In contrast, the Erwin *reports* and the Huang inventory forms are not suitable for financial data associated with specific modalities of medical facilities. *See, e.g.,* Huang, Figures 60-61. Instead, the Erwin reference discloses *reports* that provide for the overall business-accounting evaluation of a company, and the Huang

reference discloses forms for managing a supply chain. *See, e.g.*, Erwin, col. 1, lines 12-15, 25-30; col. 3, lines 30-34; Huang, Figures 60-61. As appreciated by those skilled in the art, the financial data of the medical facility associated with modalities (including projected changes) is incongruous with the Erwin data of common operations of a general company and with the supply chain management information of the Huang reference. *See, e.g.*, Erwin, col. 5, lines 39-44; col. 6, lines 49-64. Without a doubt, Erwin and Huang do not teach a *financial report based on analysis of financial data of a medical facility associated with a modality*, much less a *pro forma financial report* based on analysis of projected *changes* associated with a medical modality. Accordingly, for these reasons as well, independent claim 1 and its dependent claims are believed to be allowable over the cited combination.

***Features of Independent Claim 19 Missing From the Cited Combination***

Claim 19 recites “an interface configured to exchange *client data* with the financial analysis system, the client data comprising financial data relating to the medical facility, and wherein the financial analysis system is configured to evaluate the client data and to generate a projected financial report for the medical facility tailored to the client data.” In stark contrast, the Erwin and Huang references are absolutely devoid of an interface configured to accommodate *client data* comprising financial data related to a *medical facility*. Similarly, Erwin and Huang are devoid of a financial report tailored to such data. *See, generally*, Erwin, col. 4, line 42 – col. 14, line 58; Figures 1-27; and Huang, col. 1, line 44 – col. 2, line 43; Figures 60-61. The cited references clearly fail to disclose techniques for evaluating client data associated with a medical facility. The Erwin and Huang systems are incompatible with specific financial data (e.g., variable and fixed costs, revenues, deductions, etc.) of *medical* institutions. The types of *interfaces* and *financial reports* recited in claim 19 are clearly structured or configured for *evaluating client data of a medical facility*, and are not a simple representation of applying the generic business accounting techniques disclosed in Erwin to a medical facility. *See* Office Action, page 2 (asserting erroneously that a medical facility in simply

an intended subject use of [the present] invention). Rather, the claimed *interface* and *financial report* denotes types of interfaces and financial reports that are different than any interface or report described in the Erwin reference or Huang references. *See, e.g., In re Bulloch and Kim*, 203 U.S.P.Q. 171, 174 (CCPA 1979) (holding that the claim language “stable color developer concentrate” is more than a mere statement of purpose). In sum, the *reports* and *interfaces* disclosed in Erwin and Huang are not suitable for exchanging, analyzing, and reporting financial and client data associated with medical facilities. *See, e.g.,* Erwin, col. 5, lines 39-44; col. 6, lines 49-64; Figures 2-27; and Huang, Figures 60-61. Accordingly, for at least these reasons, independent claim 19 and its dependent claims are believed to be allowable over the cited combination.

***Features of Independent Claim 34 Missing From the Cited Combination***

Claim 34 recites “providing an interface having a form for entering *client data* relating to the healthcare facility, wherein the client data comprises a healthcare category and financial data including projected *changes* in at least a portion of the financial data; financially analyzing and projecting at least a portion of the financial data over a future outlook period . . . and returning a pro forma financial report to a client.” Conversely, the Erwin and Huang references, taken alone or in combination, do not teach, suggest, or disclose a *form* for entering of client data related to a healthcare facility and healthcare category, nor a *financial report* of the financial analysis of such data. Instead, as discussed, Erwin provides for forms and reports for “financial spreading and forecasting which highlights the operating profitability and cash-flow generating ability of a company’s operations.” Erwin, col. 1, lines 33-37. The Erwin system displays the financial forecast for the user, and the user assesses the operating profitability and cash flow-generating capability of the entity or company based on the financial forecast. Col. 3, lines 30-34; col. 5, lines 39-44. A further emphasis in Erwin is global forecasting assumptions. Col. 11, line 12 – col. 12, line 60. Erwin simply does not disclose forms or financial reports configured to financially analyzing healthcare category data including projected changes. Likewise, the Huang reference is directed to “a system for supporting

management decisions associated with manufacturing of *service supply chains*,” and clearly has nothing to do with a form for entering *client data* relating to the healthcare facility, or for generating an associated pro forma financial report. Huang, col. 1, lines 13-15 (emphasis added). Therefore, for at least these reasons, independent claim 34 and its dependent claims are believed to be allowable over the Erwin reference.

In addition, in response to the Examiner’s assertion regarding “intended use,” the Applicants reiterate that the *forms* or *financial reports* for financially analyzing *healthcare category* data are recited in the body (not the preamble) of independent claim 34, such that these claim recitations give meaning and define the scope of the claimed subject matter. For example, the recited features of “healthcare facility” and “healthcare category data” associated with the *forms* and *financial reports* are recited in the *body* of claim 34, and thus define boundaries of the claimed subject matter of *specific forms and reports* not disclosed by the Erwin and Huang references. These claim features must be considered by the Examiner in formulating a rejection of claim 34. *See Ex parte Clapp*, 227 U.S.P.Q. at 972 (explaining that to establish a *prima facie* case of obviousness, the Examiner must show that the modified reference includes *all* of the claimed elements). It is clear that no forms or financial reports in the Erwin reference read on the claim elements of claim 34. *See, e.g.*, col. 5, lines 39-44; col. 6, lines 49-64; Figures 2-27. Further, the Examiner’s vague modification of Erwin fails to reach these elements of claim 34. *See* Office Action Mailed October 8, 2004, pages 2-3

***Features of Independent Claim 43 Missing From the Cited Combination***

Claim 43 recites “an *Internet query form* having a plurality of data entry fields configured for accepting financial data of the *healthcare facility* . . . and *having a healthcare procedure field* for entering a revenue statistic of a *healthcare procedure*; and an *Internet results page* for displaying a projected financial statistic from the financial analysis system.” In contrast, Erwin and Huang do not teach, suggest, or disclose a *form* having data entry *fields* accepting financial data of a health care facility, nor a healthcare



procedure field in such a form. Furthermore, Erwin and Huang clearly do not disclose a *system* for financially analyzing a healthcare facility or healthcare procedure. Thus, Erwin and Huang, taken alone or in combination, can not teach the related *Internet results page*. Again, Erwin is instead directed to “manipulating historic accounting data and producing financial spreads and forecasts” for a generic company or entity with no mention of a healthcare facility or specific healthcare procedure. See, e.g., col. 1, lines 12-15. Further, the Erwin reference, as improperly and unclearly modified by the Examiner, does not disclose these features, such as a *system* for financially analyzing a healthcare facility or procedure. See Office Action Mailed October 8, 2004, pages 2-3. For these reasons, independent claim 43 and its dependent claims are believed to be allowable over the cited combination of Erwin and Huang.

***Request Withdrawal of Rejection***

For these reasons, the Applicants respectfully requests withdrawal of the foregoing combination the corresponding rejections under 35 U.S.C. § 103.

***Improper Combination - Lack of Objective Evidence of Reasons to Combine***

In addition, the Examiner has not shown the requisite motivation or suggestion to modify or combine the cited references to reach the present claims. As summarized above, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner combined the cited references based on the *conclusory and subjective statement*, stating that “because it would have provided a more comprehensive and efficient system for management analysis of business operations it would have been obvious to one skilled in the art at the time of the invention to add the teachings of Hu to those of Erwin, and to add those of Erwin to those of Hu for the same reasons.” See Office Action, page 3. Accordingly, Applicants challenge the Examiner to produce

*objective evidence* of the requisite motivation or suggestion to combine the cited references, or remove the foregoing rejection under 35 U.S.C. § 103.

***Improper Combination – References Teach Away From One Another***

In addition to the complete lack of objective evidence, the Applicants stress the cited references teach away from one another and, therefore, are not properly combinable. *See In re Grasselli*, 713 F.2d 731 at 743. First, Applicants stress that Huang does not disclose the feature of “purchasing analysis” in the manner asserted by the Examiner or in any related manner as recited in the claims. *See* Office Action, page 3. Therefore, Applicants traverse the contention by the Examiner that such a feature can be incorporated from Huang into Erwin. Second, the cited references teach contrastingly different intended purposes and principles of operation, which would change if the cited references were combined as suggested by the Examiner. As summarized above, a proposed modification or combination of references is entirely improper and insufficient to support a *prima facie* case of obviousness, where the proposed modification or combination would change the principle of operation of the cited reference or render the cited reference unsatisfactory for its intended purpose.

The primary reference, Erwin, teaches a principle of operation that provides for a standalone system requiring input by a user each time an accounting report is generated. *See* Erwin, Figures 2-23. The accounting report gives financial spreading and forecasting for a single company based on historical data and calculated assumptions. *See* Erwin, col. 5, lines 39-44; col. 6, lines 49-64. In contrast, the principle of operation of Huang provides for a system that interacts with other systems and considers multiple companies. *See* Huang, col. 1, line 44 – col. 2, line 43 (noting that the Huang system operates “in an interactive and dynamic decision support to a single or a set of users.”); col. 4, line 45 – col. 6, line 47. It is simply not possible to incorporate the highly interactive analysis of Huang into the standalone system of Erwin. In view of these contrasting different principles of operation, the Examiner’s proposed combination of the Erwin and Huang

references is absolutely improper and cannot stand. Indeed, substantial redesign of the Erwin system would be required. In view of these incompatible principles of operation, the cited references cannot be combined and the Examiner's rejection is improper.

For these reasons, the Applicants respectfully requests withdrawal of the foregoing combination the corresponding rejections under 35 U.S.C. § 103.

***Request Evidence to Support Official Notice***

Essentially, the Examiner has taken Official Notice of facts outside of the record that the Examiner apparently believes are capable of demonstration as being "well-known" in the art. Therefore, in accordance with M.P.E.P. § 2144.03, the Applicants hereby seasonably traverse and challenge the Examiner's use of Official Notice. Specifically, the Applicants respectfully request that the Examiner produce evidence in support of the Examiner's position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action. If the Examiner finds such a reference and applies it in combination with the presently cited references, the Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses the allegedly "well known" elements of the instant claim, as discussed above, or withdraw the rejection.

***Request Removal of the Huang Reference as Non-Analogous Art***

Based on the foregoing two-part non-analogous art test, the Huang reference does not qualify as analogous art. In regard to the first step of the *Bott* test, the Huang system falls in the field of developing supply chain management systems. See Huang, col. 1, lines 44-63. Therefore, the Huang reference is not in the field of Applicant's endeavor. In regard to the second step of the *Bott* test, the problems addressed by Huang have no relation to the problems addressed by the present inventors in the present application. There is no evidence whatsoever that similar problems exist in these disparate fields of art. The Huang reference is clearly not reasonably pertinent to the particular problems addressed by the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir.

1993). Embodiments of the present technique are directed to analyzing purchases of medical resources, whereas Huang is directed to resolving inventory problems. See Specification, page 4, lines 14-22; Huang, col. 1, lines 23-42. Accordingly, the Huang reference is believed to be non-analogous art. Applicant respectfully requests removal of the Huang reference from consideration. For these reasons, the Applicants respectfully requests withdrawal of the rejections under 35 U.S.C. § 103.

### **Conclusion**

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

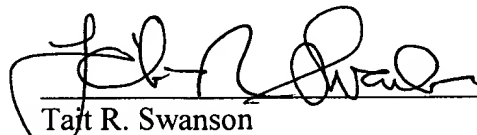
### ***Authorization for Extensions of Time and Payment of Fees***

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof. The Commissioner is authorized to charge any fees which may be required, to the Deposit Account No. 07-0845; Order No. GEMS:0122/YOD (15-EC-5773).

Respectfully submitted,

Date:

July 8, 2005



Taft R. Swanson

Registration No. 48,226

FLETCHER YODER

P.O. Box 692289

Houston, TX 77269-2289

(281) 970-4545